

REMARKS

The Examiner is thanked for his Office Action. Claims 1-27 are pending in the application. Claims 1-27 are pending, and were each rejected. All rejections are traversed, below. Reconsideration and allowance are respectfully requested.

CLAIM REJECTIONS -- 35 U.S.C. §103

Claims 1-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Tsubai, et al.* (U.S. Patent Application No. 2004/0070522, hereinafter Tsubai) in view of *Kandogan, et al* (U. S. Patent No. 6,765,556, hereinafter Kandogan). These rejections are traversed.

In ex parte examination of patent applications, the Patent Office bears the burden of establishing a prima facie case of obviousness. (MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a prima facie basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a prima facie case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a prima facie case of unpatentability, then without more the Applicant is entitled to grant of a patent. (In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (MPEP § 2142).

Claim 1 requires, among other limitations, "if the press of the first key is not released before the press of the second key is received, then generating a result value corresponding to the secondary input value of the second key indicated by the row value of the first key". This limitation is not taught or suggested by the cited art, alone or in combination.

Tsubai describes a system and method for entering data on a "truncated" alphanumeric keyboard. Tsubai's approach, in at least some embodiments, includes generating a chosen alphanumeric character by simultaneously pressing certain key combinations. As the Examiner concedes, Tsubai does not teach the first key having a row value, or generating a result value corresponding to the secondary input value of the second key indicated by the row value of the first key when the press of the first key is not released before the press of the second key is received. Tsubai does not teach or suggest that row position or keypad position of any of the simultaneously-pressed keys is of any

importance at all, as indicated by the description in paragraph 0023 that the keys need not be aligned horizontally or vertically, but can be “offset, diagonal, staggered, or any other … alignment.”

Kandogan describes a method for entering data on an alphanumeric keyboard using a series of two-key sequences of keypresses. According to Kandogan, a first key is pressed and released, then a second key is pressed and released, and each of these series of keypresses corresponds to a different alphanumeric character. Kandogan does discuss different rows of keys, but at no time discloses a “row value” as in claim 1, and therefore cannot teach or suggest generating a result value corresponding to the secondary input value of the second key indicated by the row value of the first key, as in claim 1.

Further, Kandogan does not teach or suggest pressing a second key before releasing a first keypress, requiring a sequence of keypresses for each character. Indeed, as illustrated by Kandogan’s claim 1, Kandogan’s system requires various keys to be presses twice in succession to generate certain characters, so the Kandogan’s system would be inoperable for at least some characters if the press of the first key is not released before the press of the second key is received, since in many cases, the “first key” and the “second key” are the same key.

So, as neither Tsubai nor Kandogan teach or suggest “if the press of the first key is not released before the press of the second key is received, then generating a result value corresponding to the secondary input value of the second key indicated by the row value of the first key”, and neither of them discuss a row value, it is clear that this feature is similarly not taught by a combination of these references, and there is no teaching or suggestion to modify these references to include such a teaching.

Claim 1 therefore distinguishes over this combination of references, as do its dependent claims 2-10. The device of claim 11 includes similar limitations, and so the same distinctions apply to claim 11 and dependent claims 12-20. The computer program product of claim 22 includes similar limitations, and so is similarly distinguished.

The rejections of claims 10-20 and 22 are therefore traversed.

Claim 21 requires “determining an input value for the key, of the multiple input values, according to whether a second key is concurrently pressed and, if a second key is concurrently pressed, the row number of the second key”. This feature is not taught or suggested by the prior art, as described above, as no combination of the art teaches or suggests considering the row number of a second key when two keys are concurrently pressed.

Claim 23 requires a “processor programmed to select from among the secondary alphanumeric characters associated with a first key based upon the keypad position of a second key that is pressed concurrently with the first key”. This feature is not taught or suggested by the prior art, as described above, as no combination of the art teaches or suggests considering the keypad position of a second key when two keys are concurrently pressed. Claims 23, and its dependent claims 24-27, are therefore distinguished over all art of record, and any combination of them.

All claims are therefore distinguished over the combination of Tsubai and Kandogan.

Even if all claim features were taught by a combination of these references, which they are not, there is no proper motivation to combine these references. The motivation to combine or modify must be specific to the actual teachings sought to be combined. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or

teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) (emphasis added). "When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), (emphasis added).

In this case, the motivation to combine the references alleged by the Examiner is "in order to have a means for receiving input in a device having an alphanumeric keypad", as stated on pages 4 and 7, before a rote recital of claim limitations. This provides no motivation at all for one of skill in the art to combine any specific teachings of Tsubai and Kandogan to match the claimed invention, since they each already teach a "means for receiving input in a device having an alphanumeric keypad". There is no suggestion in either reference that the different methods they teach are incomplete or ineffective, motivating one of skill in the art to look elsewhere for a relevant teaching. In fact, as described above, the different approaches teach away from each other, as Tsubai relies on simultaneous keypresses, which would be inoperable in Kandogan's system. The reverse is also true – relying on only keypress sequences and not simultaneous keypresses would render Tsubai's system ineffective.

There is certainly no teaching or suggestion in the art regarding a specific modification of Tsubai to include the consideration of “rows” as in Kandogan, as Kandogan disclaims the importance of specific rows.

The Examiner also makes other statements of “motivation”, e.g., on page 11, which appear to be nothing but a recitation of claim limitations. As the Examiner is well aware, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In this case, it is not even clear the references can be combined, and there is nothing in the art to suggest that it would be desirable to do so.

Without a proper and specific motivation to combine the references to produce the claimed invention, there can be no proper obviousness rejection.

All rejections are traversed.

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CONCLUSION

As a result of the foregoing, the remaining claims in the Application are believed to be in condition for allowance, and reconsideration and allowance is respectfully requested.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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